

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Dutta et al.	§	
	§	Group Art Unit: 3691
Serial No. 09/833,347	§	
	§	Examiner: Kesack, Daniel
Filed: April 12, 2001	§	
	§	
For: Method and Apparatus for	§	
Incorporating Scanned Checks into	§	
Financial Applications	§	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on April 17, 2007.

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-50

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 13-15, 18, 31-33 and 46-48
2. Claims withdrawn from consideration but not canceled: 9-15, 17, 18, 27-33 and 42-48
3. Claims pending: 1-8, 16, 19-26, 34-41, 49 and 50
4. Claims allowed: none
5. Claims rejected: 1-8, 16, 19-26, 34-41, 49 and 50
6. Claims objected to: none

C. CLAIMS ON APPEAL

The claims on appeal are: 1-8, 16, 19-26, 34-41, 49 and 50

STATUS OF AMENDMENTS

An amendment after final rejection was filed by Appellants on February 20, 2007. In an Advisory Action dated April 6, 2007, the Examiner provided no indication of whether or not such amendment was entered.

SUMMARY OF CLAIMED SUBJECT MATTER

Many financial applications and programs are present for users to perform financial planning and management. For example, Quicken is a financial planning program available from Intuit, Inc. Versions of such programs such as Pocket Quicken are available for mobile devices like the Palm handhelds available from Palm, Inc. Quicken and other programs allow for managing finances in areas, such as, for example, banking, investing, taxes, planning, loans, and spending and saving. Many of these programs allow a user to pay bills on-line or to access information from a user's financial institution. A user may even access checks issued by a user along with an identification of which checks have cleared. These types of capabilities, however, do not reflect checks issued *to* a user. Presently, a user is required to enter check information into the financial program, deposit the checks, and reconcile deposits from financial statements received from the user's financial information. The features of the currently pending claims provide an improved method and apparatus for easier entry of information for checks issued to a user.

A. CLAIM 1 - INDEPENDENT

Claim 1 is directed to a method for processing a check (Specification page 16, lines 19-22). A check is received from a user at an automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400). The check is scanned to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404). The image is transmitted to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412). A transaction involving the check is performed at the financial institution data processing system to generate a transaction result (Specification page 8, lines 24-25 and page 26, lines 16-18; Figure 7, element 702). The transaction result is transmitted to the automatic teller machine (Specification page 15, lines 15-17). The image and the transaction result are transmitted to a mobile device associated with the user (Specification page 15, lines 17-19, page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

B. CLAIM 9 - INDEPENDENT

Claim 9 is directed to a method for processing a check at an automatic teller machine (Specification page 16, lines 12-13; Figure 15, all elements). The method includes a step of creating a new check at the automatic teller machine in response to verifying a user request from a user requesting the new check (Specification page 16, lines 12-18, page 18, lines 7-29 and page 24, lines 3-20; Figure 10, all elements except element 1516). The method also includes a step of transmitting an image of the new check to the user (Specification page 16, lines 12-15; Figure 15, element 1516).

C. CLAIM 16 - INDEPENDENT

Claim 16 is directed to a data processing system. The data processing system includes a bus system, a communications unit connected to the bus system, a memory connected to the bus system, wherein the memory includes a set of instructions, and a processing unit connected to the bus system. The processing unit executes the set of instructions to (i) receive a check from a user at the automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400), (ii) scan the check to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404); transmit the image to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412), (iii) receive a transaction result involving the check from the financial institution data processing system (Specification page 15, lines 15-17), and (iv) transmit the image and the transaction result to a mobile device associated with the user (Specification page 15, lines 17-19, page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

D. CLAIM 17 - INDEPENDENT

Claim 17 is directed to a data processing system comprising a bus system, a communications unit connected to the bus system, a memory connected to the bus system, wherein the memory includes a set of instructions, and a processing unit connected to the bus system. The processing unit executes the set of instructions to (i) generate a new check at the automatic teller machine in response to verifying a user request from a user requesting the new

check (Specification page 16, lines 12-18, page 18, lines 7-29 and page 24, lines 3-20; Figure 10, all elements and Figure 15, all elements except element 1516), and (ii) transmit an image of the new check to the user (Specification page 16, lines 12-15; Figure 15, element 1516).

E. CLAIM 19 - INDEPENDENT

Claim 19 is directed to a data processing system for processing a check (Specification page 16, lines 19-22). The data processing system includes receiving means for receiving a check from a user at an automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400). The data processing system also includes scanning means for scanning the check to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404). The data processing system also includes transmitting means for transmitting the image to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412). The data processing system also includes receiving means for receiving a transaction result involving the check from the financial institution data processing system (Specification page 15, lines 15-17). The data processing system also includes transmitting means for transmitting the image and the transaction result to a mobile device associated with the user (Specification page 15, lines 17-19, page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

The equivalent structure for performing each of the receiving means, scanning means transmitting means for transmitting the image, receiving means and transmitting means for transmitting the image and the transaction result is data processing element 600 of Figure 6.

F. CLAIM 27 - INDEPENDENT

Claim 27 is directed to a data processing system for processing a check at an automatic teller machine (Specification page 16, lines 12-13; Figure 15, all elements). The data processing system includes generating means for generating a new check at the automatic teller machine in response to verifying a user request from a user requesting the new check (Specification page 16, lines 12-18, page 18, lines 7-29 and page 24, lines 3-20; Figure 10, all elements and Figure 15, all elements except element 1516). The data processing system also includes transmitting means for

transmitting an image of the new check to the user (Specification page 16, lines 12-15; Figure 15, element 1516).

The equivalent structure for performing each of the generating means and transmitting means is data processing element 600 of Figure 6.

G. CLAIM 34 - INDEPENDENT

Claim 34 is directed to a computer program product in a computer readable medium for processing a check (Specification page 16, lines 19-22; page 28, line 20 – page 29, line 6). The computer program product includes first instructions for receiving a check from a user at an automatic teller machine (Specification page 15, lines 9-11, page 16, lines 22-23 and page 22, line 30; Figure 5, element 504 and Figure 14, element 1400). The computer program product also includes second instructions for scanning the check to generate an image (Specification page 15, lines 11-13, page 16, lines 24-29, page 19, lines 27-30 and page 23, lines 2-7; Figure 8, element 802 and Figure 14, element 1404). The computer program product also includes third instructions for transmitting the image to a financial institution data processing system (Specification page 15, lines 13-15 and page 23, lines 15-21; Figure 7, elements 700, 702 and 704 and Figure 14, element 1412). The computer program product also includes fourth instructions for receiving a transaction result involving the check from the financial institution data processing system (Specification page 15, lines 15-17). The computer program product also includes fifth instructions for transmitting the image and the transaction result to a mobile device associated with the user (Specification page 15, lines 17-19, page 20, lines 5-7 and page 25, lines 9-29; Figure 7, element 706 and Figure 16, elements 1600-1606).

H. CLAIM 42 - INDEPENDENT

Claim 42 is directed to a computer program product in a computer readable medium for processing a check at an automatic teller machine (Specification page 16, lines 12-13; page 28, line 20 – page 29, line 6; Figure 15, all elements). The computer program product includes first instructions for generating a new check at the automatic teller machine in response to verifying a user request from a user requesting the new check (Specification page 16, lines 12-18, page 18, lines 7-29 and page 24, lines 3-20; Figure 10, all elements and Figure 15, all elements except

element 1516), and second instructions for transmitting an image of the new check to the user (Specification page 16, lines 12-15; Figure 15, element 1516).

GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to review on appeal are as follows:

1. Whether Claims 1, 5-8, 19, 23-26, 34 and 38-41 are obvious over *Hyde, Jr.*, U.S. Patent No. 6,038,553, in view of *Uhland, Sr.*, U.S. Patent No. 5,444,794, and further in view of *Joao et al.*, U.S. Patent Application Publication No. 2001/0051920 under 35 U.S.C. § 103;
2. Whether Claims 2, 4, 20, 22, 35 and 37 are obvious over *Hyde, Jr.*, in view of *Uhland, Sr.* and *Joao*, as applied above, and further in view of *Jones et al.*, U.S. Patent No. 6,661,910 under 35 U.S.C. § 103;
3. Whether Claims 3, 21 and 36 are obvious over *Hyde, Jr.*, in view of *Uhland, Sr.*, *Joao*, and *Jones*, as applied above, and further in view of the *Souccar* article "Visa in Partnership to Develop Wireless Financial Applications." under 35 U.S.C. § 103; and
4. Whether Claims 49 and 50 are obvious over *Hyde, Jr.*, in view of *Uhland, Sr.*, *Joao*, as applied to Claims 1 and 19 above, and further in view of *Ansley*, U.S. Patent Application Publication No. 2002/0133437 under 35 U.S.C. § 103.
5. Whether Claim 16 is allowable as no ground of rejection has been made with respect to such pending claim.

ARGUMENT

With respect to Claim 1, the primary issue is whether the Hyde/Uhland/Joao combination teaches/suggests transmitting both a check image and the transaction results to a mobile device. Uhland is alleged to teach the transmitting of both a check image and the transaction result to a user, and Joao is alleged to teach a mobile device that receives a transaction notification, but none of the references teaches/suggests transmitting an image of the check to a mobile device.

With respect to Claim 5 (which is also rejected using the Hyde/Uhland/Joao combination), the issue is whether the combination of references teaches/suggests the claimed feature of sending an alert for the transaction to *a plurality of users associated with an account*, the account being updated based upon the transaction result. The Examiner fails to address the plurality of users feature of Claim 5 and thus has failed to allege a prima facie showing of obviousness.

With respect to Claim 8 (which is also rejected using the Hyde/Uhland/Joao combination), the issue is whether the combination of references teaches/suggests sending an *image of the user* with the image of the check to the mobile device. The Examiner fails to address the user image feature of Claim 5 and thus has failed to allege a prima facie showing of obviousness.

With respect to Claim 19, the primary issue is whether the Hyde/Uhland/Joao combination teaches/suggests automated transmitting of both a check image and the transaction results to a mobile device by a data processing system. Uhland is alleged to teach the transmitting of both a check image and the transaction result to a user, and Joao is alleged to teach a mobile device that receives a transaction notification, but none of the references teaches/suggests transmitting an image of the check to a mobile device.

With respect to Claim 34, the primary issue is whether the Hyde/Uhland/Joao combination teaches/suggests a single computer readable medium having a computer program product that provides all of the claimed steps that synergistically co-act together. Various snippets from unrelated and incompatible systems are pieced together using Appellants' own teachings as a blueprint, and thus impermissible hindsight is used in such claim rejection.

With respect to Claim 3, the primary issue pertains to the cited Souccar reference, which is a press release announcing a joint development effort to develop a financial application for a

mobile device. This press release announces an ‘intent to develop’ such an application, and thus is actually evidence that such a program did not exist at the time of the press release. This press release is also non-enabling with respect to the features it is alleged to teach.

With respect to Claim 49, the issue is whether the combination of references teaches use of a mobile device as a relay such that the check image and transaction result are transmitted to the mobile device, and this mobile device transmits this check image and transaction device to another data processing system for processing by a financial program at the another data processing system. One reference teaches transmitting of transaction results (but not a check image) to a mobile device, and another reference teaches sending a transaction (but not a check image) from a mobile device to another data processing system. However, the only teaching/suggestion for performing both of these steps together such that the mobile device is in effect a relay comes from our own patent application. In addition, this combination doesn’t teach/suggest the relay, by a mobile device, of *both the transaction result and the check image*.

With respect to Claim 16, the issue is whether such claim is allowable as it is not rejected.

A. GROUND OF REJECTION 1 (Claims 1, 5-8, 19, 23-26, 34 and 38-41)

Claims 1, 5-8, 19, 23-26, 34 and 38-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, U.S. Patent No. 6,038,553, in view of *Uhland, Sr.*, U.S. Patent No. 5,444,794, and further in view of *Joao et al.*, U.S. Patent Application Publication No. 2001/0051920.

A.1. Claim 1

Claim 1 is directed to a method for processing a check. A check from a user is received at an automatic teller machine. The check is scanned to generate an image. This image is then transmitted to a financial institution data processing system. The financial institution data processing system performs a transaction involving the check to generate a transaction result. This transaction result is transmitted back to the automatic teller machine. *Both the image of the scanned check and the transaction result (from the financial institution data processing system) are transmitted to a mobile device associated with the user.* Appellants respectfully submit that none of the cited references teach or suggest *transmitting both (1) the image and (2) the*

transaction result to a mobile device associated with the user. In rejecting Claim 1, the Examiner states:

“Uhland teaches transmitting a check image and a transaction result to a user (column 5 lines 6-21).”

and

“Joao discloses a financial transaction and wireless communication device and method, wherein a user receives transaction notification data, which identifies a transaction, via a mobile device (abstract and paragraph 49).”

Appellants urge that Uhland does *not* teach the transmitting of both a check image and a transaction result to a user, as alleged by the Examiner. *Uhland* states at column 5, lines 6-21 the following:

“Preferred embodiments of the present invention capture images of both sides of a check. In addition, the account number on the check is automatically read by an OCR device. When the teller keys the check amount information into the system, the image of the check, the bank number, account number, check number, and check amount data are placed in a file for: (1) balancing the teller's daily work; (2) debiting the amount of the check from the customer's account (i.e., for on-us checks); (3) **sending check images and amounts back to the account holder**; (4) truncating the check (for on-us checks); and (5) automatically encoding the amount on all non-on-us checks. Regarding the latter operation, the check may be automatically encoded without manual intervention since the account number, bank number, and check number are known.” (emphasis added by Appellants)

However, as stated by *Uhland* at column 1, lines 16-23:

“Newer check processing systems employ imaging to capture digital images of the checks. **Once these digital images have been captured, a bank may send each of its customers monthly statements with images of the customer's cashed checks instead of the checks themselves.** Such image processing allows the checks to be “truncated” prior to shipment to the customer, reducing in-house check processing costs.” (emphasis added by Appellants)

and as stated by *Uhland* at column 2, lines 45-55:

“Similarly, on-us read and amount-encoded images (as opposed to the checks themselves) are passed to a balancing station 20, which performs the balancing process with the on-us check images. The on-us images of checks that were not properly amount encoded are provided to a reject key entry station 22. From there, the latter images are passed to the balancing station 20. From the balancing station 20, **the on-us check images are sent to a mainframe computer 24, which prepares customer statements to be sent to the customers associated with the respective checks.**” (emphasis added by Appellants)

and as stated by *Uhland* at column 9, lines 11-15:

“2. A system as recited in claim 1, wherein said computer is further programmed to merge said amount data with said image data, **whereby the preparation of a customer statement depicting an image of said check and amount of said check is enabled.**” (emphasis added by Appellants)

and as stated by *Uhland* at column 10, lines 11-18:

“6. A system as recited in claim 5, wherein said computer is further programmed to merge said amount data with said image data, **whereby the preparation of a customer statement depicting an image of said check and amount of said check is enabled;** and wherein said computer is further programmed to merge multiple on-us check images corresponding to on-us checks associated with a common account number.” (emphasis added by Appellants)

Thus, the cited *Uhland* reference only contemplates the sending of a check image to a user by way of the customer’s statement, which is traditionally known to those of ordinary skill in the art to be a statement mailed to the user at the end of each month (*Uhland* col. 3, lines 25-30).

Further, and importantly, *Uhland* does not contemplate sending a check image to a mobile device, and in fact is keen on reducing overall processing costs by *only sending images back to the customer in their normal monthly account statement* (*Uhland* column 6, lines 59-62). Therefore, a person of ordinary skill in the art would not have been motivated to modify the

teachings of *Uhland* to include the claimed feature of *sending both a check image and a transaction result to a mobile device* as such processing would increase transaction processing for which *Uhland* seeks to reduce. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection *unless the prior art suggested the desirability of such a modification*. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (emphasis added by Appellants). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, *there must be a suggestion or motivation in the reference to do so*. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added by Appellants). The reference expressly teaches away from any desire to provide additional check processing, and therefore there is no suggestion or other motivation to modify such teachings in accordance with the missing claimed feature associated with respect to Claim 1 - transmitting of both a scanned image of a check and associated transaction information to a mobile device – further evidencing non-obviousness with respect to Claim 1.

As to the cited *Joao* passage at *Joao's* abstract and paragraph 49, there *Joao* states:

“An apparatus and method for collecting account transaction information, including a receiver for receiving account transaction information, wherein the account transaction information contains information regarding the transaction and at least one of the identity of and contact information for the at least one of merchant, vendor, bank, financial institution, brokerage firm, electronic money account, communication account provider, electronic information provider, electronic transaction intermediary, involved in the transaction, wherein the receiver receives a request to receive at least one of the account transaction information, the information regarding the transaction, and the at least one of the identity of and contact information for the at least one of merchant, vendor, bank, financial institution, brokerage firm, electronic money account, communication account provider, electronic information provider, electronic transaction intermediary, involved in the transaction, a memory device for storing the account transaction information, a processor for processing at least one of the account transaction information and the request, wherein the processor generates a response to the request, and **a transmitter for transmitting the response to the request to a requesting individual.**” (Abstract); and

“[0049] In another alternate embodiment, the apparatus and method of the present invention may also be utilized so as to provide authorization, notification and/or security for, and in conjunction with wireless communication devices, wireless telephones, cellular communication devices and/or cellular telephones, wireless and/or mobile telephones

and/or communication systems, wherein a wireless, cellular and/or mobile communication devices and/or telephone owner and/or account holder can be notified of a transmission and/or an attempted transmission and/or telephone call made with his or her wireless, cellular, or mobile communication device and/or telephone and/or with the telephone number and/or account information, which information may include, but not be limited to, transmission codes and/or associated signatures and/or data which corresponds to his or her wireless, cellular, or mobile communication device and/or telephone.”

As can be seen, these cited Joao passages describe (1) transmitting a response to a request to a requesting individual (which does not teach or otherwise suggest transmitting a check image to a mobile device, as per the (missing) feature of Claim 1), and (2) notifying an owner of a mobile device of a transmission or attempted transmission made with their mobile device (which does not teach or otherwise suggest transmitting a check image to a mobile device). Such notification is made to provide the owner a notification of a possible unauthorized use of such mobile device as being lost, stolen or illegally cloned (*Joao* paragraph 320). Thus, the cited *Joao* reference does not overcome the teaching/suggestion deficiency identified above with respect to the cited *Uhland* reference, since there is *no teaching/suggestion of transmitting a check image to a mobile device*. Therefore, a proper prima facie case of obviousness has not been established by the Examiner¹, and therefore Claim 1 has been erroneously rejected under 35 U.S.C. 103².

A.2. Claims 5, 23 and 38

Appellants initially show error in the rejection of Claim 5 for reasons given above with respect to Claim 1 (of which Claim 5 depends upon).

Further with respect to Claim 5, the combination of references fails to teach/suggest the claimed feature of sending an alert for the transaction to a plurality of users associated with an

¹ In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Appellants).

² If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

account, the account being updated based upon the transaction result. The Examiner does not address this claimed feature in the final rejection of Claim 5, and therefore has not properly established a prima facie showing of obviousness with respect to Claim 5. Therefore, Claim 5 has been erroneously rejected under 35 U.S.C. 103.

A.3. Claims 8, 26 and 41

Appellants initially show error in the rejection of Claim 8 for reasons given above with respect to Claim 1 (of which Claim 8 depends upon).

Further with respect to Claim 8, the combination of references fails to teach/suggest *sending an image of the user with the image of the check to the mobile device*. The Examiner does not address this claimed feature in the final rejection of Claim 8, and therefore has not properly established a prima facie showing of obviousness with respect to Claim 8. Therefore, Claim 8 has been erroneously rejected under 35 U.S.C. 103.

A.4. Claim 19

Appellants initially show error in the rejection of Claim 19 for similar reasons to those given above with respect to Claim 1. Still further, Claim 19 is directed to a data processing system that performs all of the means for elements of (i) receiving, (ii) scanning, (iii) transmitting (scanned check image) to a financial institution, (iv) receiving, and (v) transmitting both the image and the transaction result to a mobile device. Providing each of these means-plus-function elements by a given data processing system provides a highly efficient and automated mechanism for processing checks with minimal or no user-intervention. In contrast, per the teachings of the cited Uhland reference, which is being used as teaching the claimed “means for transmitting the image and the transaction result”, Uhland actually teaches that copies of check images are provided to the user in their monthly statement (col. 2, lines 53-55) *in paper form* (col. 6, lines 59-62). Thus, these teachings do not contemplate the automated *transmitting of both an image and a transaction result that is performed by a data processing system*. Instead, a paper monthly statement is sent to a user, and such sending of a monthly statement does not teach or otherwise suggest an automated process performed by a data processing system of *transmitting both an (i) image and (ii) a transaction result to a mobile device*. Thus, it is further urged that Claim 19 has

been erroneously rejected under 35 U.S.C. 103 as there are additional claimed features not taught or suggested by the cited references.

A.5. Claim 34

Appellants initially show error in the rejection of Claim 34 for similar reasons to those given above with respect to Claims 1 and 19. In addition, it is urged that none of the cited references teach or suggest a single computer program product in a computer readable medium that comprises all of the instructions, recited in such claim, that synergistically co-act together with one another. Instead, various snippets from dissimilar and incompatible systems are patched together in an attempt to establish obviousness. However, the only teaching/suggestion for performing all *of these steps together* in a synergistic fashion in a single computer readable medium comes from Appellants' own patent application. As the Federal Circuit outlines in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole". Inventions typically are new combinations of existing principles or features. *Emvlt. Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtuall all [inventions] are combinations of old elements"). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – often the essence of invention. *Id.* Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, Federal Circuit, No. 04-1493, June 9, 2005. Quite simply, there is

no teaching, suggestion or other motivation to combine the unrelated snippets from the three references into a single, unitary computer readable medium to provide check processing techniques such as sending an image of a check received at an automatic teller machine to a mobile device of the user who provided such check to the automated teller machine. Thus, it is further urged that Claim 34 has been erroneously rejected under 35 U.S.C. 103.

B. GROUND OF REJECTION 2 (Claims 2, 4, 20, 22, 35 and 37)

Claims 2, 4, 20, 22, 35 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, in view of *Uhland, Sr.* and *Joao*, as applied above, and further in view of *Jones et al.*, U.S. Patent No. 6,661,910.

B.1. Claims 2, 4, 20, 22, 35 and 37

Appellants urge error in the rejection of representative Claim 2 for reasons given above with respect to the missing claimed features associated with Claim 1 (of which Claim 2 depends upon), as the additional cited reference to Jones does not overcome the teaching/suggestion deficiency identified above with respect to Claim 1 (transmitting of both a scanned image of a check and associated transaction information to a mobile device associated with a user who provides such check to an automated teller machine).

C. GROUND OF REJECTION 3 (Claims 3, 21 and 36)

Claims 3, 21 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, in view of *Uhland, Sr.*, *Joao*, and *Jones*, as applied above, and further in view of the *Souccar* article "Visa in Partnership to Develop Wireless Financial Applications."

C.1. Claims 3, 21 and 36

Appellants initially show error in the rejection of Claim 3 for reasons given above with respect to Claim 1 (of which Claim 3 depends upon), as the additional cited references to Jones and Souccar do not overcome the teaching/suggestion deficiency identified above with respect to Claim 1 (transmitting of both a scanned image of a check and associated transaction information to a mobile device associated with a user who provides such check to an automated teller machine).

Further with respect to Claim 3, the cited *Souccar* reference is a press release announcing a joint development effort to develop a financial application for a mobile device. This press release announces an ‘intent to develop’ such an application, and thus is actually evidence that such a program *did not exist at the time of the press release*.

This press release is also non-enabling with respect to the features it is alleged to teach, as it states that one company (Visa) *must collaborate* with another company (Aether Systems) to provide financial applications for mobile devices sometime *in the future* - evidencing substantial development activities were further required between two large companies for the development of such applications, and thus such applications were not in the possession of the public or of a person of ordinary skill in the art³. Thus, it is urged that Claim 3 has been erroneously rejected, as the cited *Souccar* reference actually evidences that the claimed features recited therein was not in the possession of the public, and (2) the cited *Souccar* reference is non-enabling with respect to the features it is alleged to teach.

Therefore, the rejection of Claims 3, 21 and 36 under 35 U.S.C. § 103(a) is further shown to be in error.

D. GROUND OF REJECTION 4 (Claims 49 and 50)

Claims 49 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hyde, Jr.*, in view of *Uhland, Sr.*, *Joao*, as applied to Claims 1 and 19 above, and further in view of *Ansley*, U.S. Patent Application Publication No. 2002/0133437.

D.1. Claims 49 and 50

With respect to Claim 49, the issue is whether the combination of references teaches use of a mobile device as a relay such that the check image and transaction result are transmitted to the mobile device, and this same mobile device transmits this check image and transaction device to another data processing system for processing by a financial program at the another data

³ Printed publication references must be enabling, thus placing the alleged disclosed matter in the possession of the public. *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994); The reference must be enabling and describe applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *In re Paulsen*, 30 F.3d, 1475, 31 USPQ2d 1671 (Fed. Cir. 1994).

processing system. One reference teaches transmitting of transaction results (but not a check image) to a mobile device, and another reference teaches sending a transaction (but not a check image) from a mobile device to another data processing system. However, the only teaching/suggestion for performing both of these steps together such that the mobile device is in effect a relay comes from Appellants' own patent application. As the Federal Circuit outlines in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention “as a whole”. Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtual all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – often the essence of invention. *Id.* Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This “as a whole” assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, Federal Circuit, No. 04-1493, June 9, 2005. In 1983, the late Judge Howard Markey made the following observation in *W.L. Gore & Associates Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), which states the basic interest protected by this test—improper hindsight analysis of prior art:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Appellants respectfully submit that the Examiner is using impermissible hindsight in rejecting Claim 49, as there is no reason, suggestion or motivation to make this combination other than Appellants' own disclosure.

Still further, because the cited *Ansley* reference is directed to a technique for synchronizing data between a mobile device and a data processing system, a person of ordinary skill in the art *would not have been motivated* to add yet an additional data processing system as then there would be three sources of data (the two data processing systems and the mobile device), and it would be unclear which data is to be synchronized due to such large number of systems. For example, would the data in the first system be the master data that is used to override other data that is inconsistent, or should the second system (or the mobile device itself) be considered the master in data synchronization? When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. "...absence of such suggestion to combine is dispositive in an obviousness determination". *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). Quite simply, synchronization doesn't work well with three distinct devices/systems due to the resulting data ambiguities, and therefore a person of ordinary skill in the art would not have been motivated to add an additional data processing system to the teachings of *Ansley* as the expressed purpose of *Ansley* – data synchronization – would be adversely impacted, and therefore there would have been no suggestion, reason or other motivation to make such a combination.

Still further, even with such improper combination using Appellants own disclosure as a blueprint in making the combination of four different references, such resulting combination still does not teach the use of a relay, by a mobile device, of both the transaction result and the check image, for similar reasons to those described in detail above with respect to Claim 1. The fact that this impermissible hindsight combination still results in missing claimed features is compelling evidence of non-obviousness, and thus it is further shown that Claim 49 has been erroneously rejected. In addition, *Ansley's* teachings, which are being used to establish a communication link and data transfer to the 'another data processing system' has no ability to process or input check images as the data that is transmitted to the another data processing

system is manually entered by a user of the mobile device (*Ansley* Figure 6, block 640; paragraph 0047). Thus, the teachings of *Ansley* do not provide a teaching/suggestion of *transmitting the image to another data processing system*, as expressly recited in Claim 49 (in combination with Claim 4)⁴. This is further evidenced by the fact that the Examiner merely alleges that *Ansley* teaches:

“*Ansley* discloses financial management system and method wherein *transaction data* is sent from a mobile device to a base station database for the purpose of synchronizing all data (figure 6 steps 615-625)” (page 7 of the Final Office Action dated 12/18/2006) (emphasis added by Appellants).

Yet, Claim 49 recites “transmitting the *image and the financial information* from the mobile device to the another data processing system” (emphasis added by Appellants). Thus, the Examiner is shown to have failed to properly establish a prima facie showing of obviousness due to this additional claimed feature that it is not taught or suggested by any of the numerous references that have been improperly combined.

Thus, it is urged that Claim 49 has been erroneously rejected under 35 U.S.C. 103 for the numerous reasons given above, including (1) improper hindsight analysis, (2) no suggestion or reason to combine the references, and (3) even with the improper combination of such a large number of references, there are still missing claimed features not taught or suggested by the cited references.

E. Claim 16

It is urged that pending Claim 16 is allowable, as it is not the subject of any rejection at all. Per 35 U.S.C. 102:

⁴ The Examiner explicitly admits that the other cited references used in the rejection of Claim 49 do not teach ‘transmitting the image and financial transaction information from the mobile device to another data processing system’ (page 7 of the Final Office Action dated 12/18/2006).

A person *shall* be entitled to a patent *unless* -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Because none of these 'unless' conditions have been established, or even alleged, by the Examiner with respect to Claim 16, Appellants are entitled to a patent for Claim 16 according to the '*person shall be entitled*' provision.

In conclusion, Appellants have thus shown numerous and substantial error in the Examiner's final rejection of all pending claims, and respectfully requests that the Board reverse such final rejection of all pending claims.

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CLAIMS APPENDIX

The text of the claims involved in the appeal are:

1. A method for processing a check, the method comprising:
receiving a check from a user at an automatic teller machine;
scanning the check to generate an image;
transmitting the image to a financial institution data processing system;
performing a transaction involving the check at the financial institution data processing system to generate a transaction result;
transmitting the transaction result to the automatic teller machine; and
transmitting the image and the transaction result to a mobile device associated with the user.
2. The method of claim 1 further comprising:
importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program.
3. The method of claim 2, wherein the financial program is located on the mobile device.
4. The method of claim 2, wherein the financial program is located on another data processing system other than the mobile device.
5. The method of claim 1 further comprising:
sending an alert for the transaction to a plurality of users associated with an account, the account being updated based upon the transaction result.
6. The method of claim 5, wherein the alert includes an identification of the transaction.

7. The method of claim 1 further comprising:
capturing an image of the user at the automatic teller machine.
8. The method of claim 7 further comprising:
sending the image of the user with the image of the check to the mobile device.
9. A method for processing a check at an automatic teller machine, the method comprising:
creating a new check at the automatic teller machine in response to verifying a user request from a user requesting the new check; and
transmitting an image of the new check to the user.
10. The method of claim 9, wherein the transmitting step comprises:
transmitting the image to a mobile device associated with the user.
11. The method of claim 9, wherein the transmitting step comprises:
sending the image in association with an e-mail message to the user.
12. The method of claim 9, wherein the the transmitting step further comprises transmitting, to the user, financial information associated with an account for which the new check is drawn against such that (i) a current account balance for the account, which accounts for an amount indicated by the new check, and (ii) the image of the new check are both accessible to the user.
16. A data processing system comprising:
a bus system;
a communications unit connected to the bus system;
a memory connected to the bus system, wherein the memory includes a set of instructions; and
a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive a check from a user at the automatic teller machine; scan the check to generate an image; transmit the image to a financial institution data processing system; receive

a transaction result involving the check from the financial institution data processing system; and transmit the image and the transaction result to a mobile device associated with the user.

17. A data processing system comprising:

a bus system;

a communications unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to generate a new check at the automatic teller machine in response to verifying a user request from a user requesting the new check; and transmit an image of the new check to the user.

19. A data processing system for processing a check, the data processing system comprising:

receiving means for receiving a check from a user at an automatic teller machine;

scanning means for scanning the check to generate an image;

transmitting means for transmitting the image to a financial institution data processing system;

receiving means for receiving a transaction result involving the check from the financial institution data processing system; and

transmitting means for transmitting the image and the transaction result to a mobile device associated with the user.

20. The data processing system of claim 19 further comprising:

importing means for importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program.

21. The data processing system of claim 20, wherein the financial program is located on the mobile device.
22. The data processing system of claim 20, wherein the financial program is located on another data processing system other than the mobile device.
23. The data processing system of claim 19 further comprising:
sending means for sending an alert for the transaction to a plurality of users associated with an account, the account being updated based upon the transaction result.
24. The data processing system of claim 23, wherein the alert includes an identification of the transaction.
25. The data processing system of claim 19 further comprising:
capturing means for capturing an image of the user at the automatic teller machine.
26. The data processing system of claim 25 further comprising:
sending means for sending the image of the user with the image of the check to the mobile device.
27. A data processing system for processing a check at an automatic teller machine, the data processing system comprising:
generating means for generating a new check at the automatic teller machine in response to verifying a user request from a user requesting the new check; and
transmitting means for transmitting an image of the new check to the user.
28. The data processing system of claim 27, wherein the transmitting means comprises:
means for transmitting the image to a mobile device associated with the user.
29. The data processing system of claim 27, wherein the transmitting means comprises:
means for sending the image in association with an e-mail message to the user.

30. The data processing system of claim 27, wherein the the transmitting means further comprises means for transmitting, to the user, financial information associated with an account for which the new check is drawn against such that (i) a current account balance for the account, which accounts for an amount indicated by the new check, and (ii) the image of the new check are both accessible to the user.

34. A computer program product in a computer readable medium for processing a check, the computer program product comprising:

- first instructions for receiving a check from a user at an automatic teller machine;
- second instructions for scanning the check to generate an image;
- third instructions for transmitting the image to a financial institution data processing system;
- fourth instructions for receiving a transaction result involving the check from the financial institution data processing system; and
- fifth instructions for transmitting the image and the transaction result to a mobile device associated with the user.

35. The computer program product of claim 34 further comprising:

- fifth instructions for importing the image and the transaction result into an end-user financial program that is useable to manage finances for the user such that both (i) a current account balance for the user, which accounts for an amount indicated by the received check, and (ii) the image of the received check are accessible to the user using the end-user financial program.

36. The computer program product of claim 35, wherein the financial program is located on the mobile device.

37. The computer program product of claim 35, wherein the financial program is located on another data processing system other than the mobile device.

38. The computer program product of claim 34 further comprising:
fifth instructions for sending an alert for the transaction to a plurality of users associated with an account, the account being updated based upon the transaction result.
39. The computer program product of claim 38, wherein the alert includes an identification of the transaction.
40. The computer program product of claim 34 further comprising:
fifth instructions for capturing an image of the user at the automatic teller machine.
41. The method of claim 40 further comprising:
sixth instructions for sending the image of the user with the image of the check to the mobile device.
42. A computer program product in a computer readable medium for processing a check at an automatic teller machine, the computer program product comprising:
first instructions for generating a new check at the automatic teller machine in response to verifying a user request from a user requesting the new check; and
second instructions for transmitting an image of the new check to the user.
43. The computer program product of claim 42, wherein the second instructions for transmitting comprises:
sub-instructions for transmitting the image to a mobile device associated with the user.
44. The computer program product of claim 42, wherein the second instructions for transmitting comprises:
sub-instructions for sending the image in association with an e-mail message to the user.
45. The computer program product of claim 42, wherein the second instructions for transmitting further comprises transmitting, to the user, financial information associated with an account for which the new check is drawn against such that (i) a current account balance for the

account, which accounts for an amount indicated by the new check, and (ii) the image of the new check are both accessible to the user.

49. The method of Claim 4, further comprising a step of transmitting the image and the financial information from the mobile device to the another data processing system.

50. The data processing system of Claim 22, further comprising means for transmitting the image and the financial information from the mobile device to the another data processing system.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.